

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERIK NELSON, JEFFREY TEACHOUT,
and LEE SPECHTS

Appeal No. 2001-2076
Application No. 09/107,057

ON BRIEF

Before COHEN, FRANKFORT, and BAHR, Administrative Patent Judges.
COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 2 through 9, 11, 14 through 16, 30 through 39, and 41. These claims constitute all of the claims remaining in the application.

Appellants' invention pertains to a board guide and a cabinet. A basic understanding of the invention can be derived from a reading of exemplary claims 15, 16, 37 and 38, respective

Appeal No. 2001-2076
Application No. 09/107,057

copies of which appear in the Appendix to the substitute appeal brief (Paper No. 28).

As evidence of obviousness, the examiner has applied the documents listed below:

Lit et al. (Lit)	3,723,823	Mar. 27, 1973
Thornicroft et al. (Thornicroft)	3,838,777	Oct. 1, 1974
Brusati et al. (Brusati)	5,467,254	Nov. 14, 1995

The following rejection is before us for review.

Claims 2 through 9, 11, 14 through 16, 30 through 39, and 41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lit in view of Brusati and Thornicroft.

The full text of the examiner's rejection and response to the argument presented by appellants appears in the supplemental answer (Paper No. 29), while the complete statement of appellants' argument can be found in the substitute appeal brief (Paper No. 28)

OPINION

In reaching our conclusion on the obviousness issue raised in this appeal, this panel of the board has carefully considered appellants' specification and claims,¹ the applied teachings,² and the respective viewpoints of appellants and the examiner. As a consequence of our review, we make the determination which follows.

This panel of the board cannot sustain the rejection on appeal.

We fully comprehend the respective teachings of the relevant Lit, Brusati, and Thornicroft references applied by the examiner,

¹ In the last line of claim 37, the recitation "guide members are" should apparently be --guide member is-- for consistency with the earlier recitation in the claim of "a guide member." The matter should be addressed by the examiner.

² In our evaluation of the applied prior art, we have considered all of the disclosure of each document for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

references which clearly address prior art features found in appellants' claimed board guide and cabinet. The problem that we readily perceive however arises when we set aside in our minds that which appellants have informed us of in the present application and focus only upon the applied patents themselves. From that perspective, it becomes clear to us that, absent the present disclosure, those having ordinary skill in the art simply would not have derived a suggestion from the overall teachings of Lit, Brusati (snap-in posts; Figs. 3 and 5), and Thornicroft (symmetrical support rails 11, 12; Fig.3) to reconfigure the board guide of Lit according to the examiner's rationale. It is noteworthy that the aforementioned rationale would necessitate a major reworking of the Lit board guide by applying particularly selected features following an ordered sequence not addressed in the applied prior art (supplemental answer, page 6) to create the claimed invention. Since the reference teachings by themselves would not have been suggestive of appellants' invention, the rejection cannot be sustained.

Appeal No. 2001-2076
Application No. 09/107,057

The decision of the examiner is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	
)	
)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JENNIFER D. BAHR)	
Administrative Patent Judge)	

ICC/lbg

Appeal No. 2001-2076
Application No. 09/107,057

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APPEAL NO. 2001-2076 - JUDGE COHEN
APPLICATION NO. 09/107,057

APJ COHEN

APJ BAHR

APJ FRANKFORT

DECISION: REVERSED

Prepared By: Lesley Brooks

OB/HD

GAU: 3600

DRAFT TYPED: 09 Jun 03

FINAL TYPED: